



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/489,514 | 01/21/2000 | S. R. Narayanan | 06618-406001 | 5937 |

20985 7590 06/13/2002

FISH & RICHARDSON, PC
4350 LA JOLLA VILLAGE DRIVE
SUITE 500
SAN DIEGO, CA 92122

EXAMINER

MERCADO, JULIAN A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1745

11

DATE MAILED: 06/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/489,514

Applicant(s)

NARAYANAN ET AL.

Examiner

Julian A. Mercado

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 7-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1745

DETAILED ACTION

Remarks

This Office Action is responsive to Applicant's amendment filed April 8, 2002.

The rejection of claims 15, 16 and 19 under 35 U.S.C. 112, second paragraph has been withdrawn.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 7-11, 13, 14, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Serpico et al. in view of Dupont Zonyl reference.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Serpico et al. in view of Dupont Zonyl reference as applied to claims 7-11, 13, 14, 18, and 20 above, in view of Kindler.

Claims 15-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Serpico et al. in view of Dupont Zonyl reference as applied to claims 7-11, 13, 14, 18, and 20 above, in view of Samuels et al.

The above rejections are maintained for the reasons of record and will not be reiterated. Applicant's arguments have been fully considered, however they are not persuasive.

Art Unit: 1745

The examiner notes Applicant's amendment to the claims to obviate the rejection under 35 U.S.C. 112, second paragraph (now withdrawn). The claims have also been amended so as to delete the term "about" for the limitation drawn to the particle size of 1 to 4 microns. In this regard, the rejection based on Serpico in view of the Dupont 30B reference, the latter relied upon to teach a particle size of 0.5 micron, has been withdrawn.

However, the rejection based on Serpico when taken in view of the Dupont Zonyl reference is maintained for the reasons of record and for the additional reasons to follow. Applicant submits that the rejection is based upon improper hindsight reasoning. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this regard, as set forth in the previous Office Action, the Dupont Zonyl reference would motivate the skilled artisan to employ its teachings of a particle size within the claimed 1 to 4 microns in Serpico's invention, for reasons such as dispersion stability and decreased surface tension, *inter alia*. Both Serpico and the Dupont Zonyl reference are disclosures which are pertinent to the use of catalyst inks and thus, the references are mutually relevant. These reasons were taken directly from the reference and outside of Applicant's disclosure. Applicant's allegation of hindsight reasoning is unfounded for this reason. Additionally, it is noted that Applicant has not directly responded to the examiner's reasoning of obviousness. For these reasons, the rejection based on Serpico in view of the Dupont Zonyl reference is maintained.

Art Unit: 1745

Applicant submits that to select particles having a very narrow size distribution such as described in the Dupont Zonyl reference would involve ignoring what Serpico teaches. This is not persuasive. Insofar as Serpico teaches a broader range of particle sizes, in view of the Dupont Zonyl reference the skilled artisan would find obvious without undue experimentation to employ a smaller particle size and to focus on the lower end of Serpico's disclosed range, for the reasons discussed *supra*.

It is noted that no arguments directed to the tertiary references, namely Kindler and Samuels et al., are presented in Applicant's response. These rejections are maintained for the reasons of record.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1745

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian A. Mercado whose telephone number is (703) 305-0511. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (703) 308-2383. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3599 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

jam

June 10, 2002

STEPHEN KALAFUT
PRIMARY EXAMINER
GROUP

(700)